

REMARKS

Claims 52 and 54 are currently pending in the instant application. The Applicant respectfully requests reconsideration in view of the foregoing remarks.

Claim Rejections- 35 U.S.C. § 103(a)

In the Office Action dated April 3, 2007, the Examiner rejected Claim 52 under 35 U.S.C. § 103(a) as obvious over Rochte et al. (US 3,545,690; hereafter Rochte) in view of Wheatcroft (CA 2,25,850; hereafter Wheatcroft).

It is stated in the Action that Rochte teaches a method for automated chemical analysis that includes the elements of Claim 52 of the instant application, except for reciting that the samples processed includes nucleic acid and the chemical reaction performed is nucleic acid amplification by thermally cycling the sample mixture. To find those elements, the Examiner looks to Wheatcroft.

It is stated in the M.P.E.P § 2143 that in order to establish a *prima facie* case of obviousness, the following criteria must be met:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "

Specifically, in the Action it is stated that the method of Rochte includes providing a translatable block assembly (402); moving the sample block assembly (402) from a first position permitting placement of the sample well tray onto the incubation device (400) to a second position permitting incubation within the incubating device (400). Reference for finding these elements is made to Rochte Figs. 3 and 5, as well as Column 9, line 65 to Column 10, line 21.

The chemical analyzer of Rochte is described as follows (see Rochte; Col. 1, lines 60-69; underline added for emphasis):

"...an automated chemical analyzer employing individual sample capsules, each of inexpensive hollow body, open bottom construction with cups and end tabs supported on

a pair of horizontal rails on which the capsules are conveyed side-by-side past processing stations in stop and go fashion by the up and down action of the rails and the to-and-fro movement of racks having teeth engaging the capsule for moving it along when the rails are up..."

The chemical analyzer taught by Rochte carries samples in sample capsules in an automated fashion to various processing stations based on a stop and go movement that is actuated by the up and down action of rails, which rails appear to be essential for the capsule transport. That the operation of the rails is required for the function of the incubator is given in Col. 10, lines 7-11 (underline added for emphasis):

"...Frame **410** also supports a vertical air cylinder **412** conveniently coupled to the vertically movable frame **408**, as at **414**, the operation of the air cylinder being tied in with the operation of vertical transport cylinder **80** for the rails **22**."

With respect to the criteria for suggestion or motivation found in cited art references, it is further stated in the MPEP (section 2143.0, paragraph VI), that the proposed modification cannot change the principle of operation of a reference:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

In Rochte, in order for the analyzer to function during the incubation of a sample, it appears that two actions must occur: 1) The incubator block **400**, supported on elongated frame **408**, which frame moves on vertical sliding means of a pair of ball slides **58**, which vertical sliding means are supported on frame **410**, which attached to frame **70**. Frame **410** further supports a vertical air cylinder **412** for moving frame **408**, moving the incubator block thereby (see Fig. 5 and Col. 10, lines 1-8). 2) Additionally, in order that no damage to the rails would occur from the solitary movement of the incubator block, vertical transport air cylinder **80** for moving rails **22** must be actuated in concert with the movement of incubator block **400** (see Fig. 3-5, and Col. 10, lines 9-10, as well as Col. 3 line 38 to Col. 4, line 7).

Therefore, in order for the apparatus of Rochte to incubate a sample with any of the various embodiments of a translatable sample block of the instant application, the entire principle of operation of the apparatus of Rochte would need to be re-examined, and the apparatus re-engineered. In that regard, the proposed modification changes the principle of operation of Rochte.

Moreover, the teachings of Wheatcroft do not overcome this deficiency. In Wheatcroft it appears that the sample blocks on which the sample trays sit during incubation are stationary, while the sample trays are rotated about the sample blocks (see page 8, lines 10-23). In that regard, Wheatcroft teaches away from a translatable sample block assembly.

As such, either taken individually or in combination, Rochte and Wheatcroft do not teach the method of Claim 52 of the instant application. Accordingly, no *prima facie* case of obviousness has been established, and the Applicant respectfully requests the rejection of Claim 52 be withdrawn.

As Claim 54 is dependent on Claim 52, the Applicant respectfully requests the rejection of Claim 54 be withdrawn for the same reasons stated for Claim 52.

CONCLUSION

The Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact me at the telephone number listed below.

Respectfully submitted,

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